

REMARKS

Claims 1 through 13 have been amended. Claims 1 through 41 remain in the application.

The Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I-Claims 1 through 13 and 41, drawn to the invention of a composition, classified in class 524, subclass 47.

Group II-Claims 14 through 25, drawn to the invention of an article, classified in class 524, subclass 47.

Group III-Claims 26 through 40, drawn to the invention of a method of making a composition, classified in class 264, subclass 141.

The Examiner has found that the inventions are distinct, each from the other, because the Groups III and I inventions are related as process of making and product made. The Examiner has also found that the inventions are distinct because the process as claimed can be used to make other and materially different products such as one that contains fillers, dyes, and/or cross-linking agents.

The Examiner has found that the inventions are distinct, each from the other, because the Groups III and II inventions are related as process of making and product made. The Examiner has also found that the inventions are distinct because the process as claimed can be used to make other and materially different products such as one that contains fillers, dyes, and/or cross-linking agents.

The Examiner has found that the inventions are distinct, each from the other, because the Groups I and II inventions are related as mutually exclusive species in an intermediate-final product relationship. The Examiner has also found that the inventions are

distinct because the intermediate product is deemed to be useful as starting material to form biodegradable packaging film and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

The Examiner has further found that these inventions have acquired a separate status in the art because of their recognized divergent subject matter, and therefore restriction for examination purposes is proper. Applicants respectfully traverse the restriction requirement.

As to the invention of Group I, this invention is directed to a polymer composition. The invention of Group II claims an article made of the polymer composition of Group I. The invention of Group III claims a method of making a polymer composition of Group I. Applicants submit that the process as claimed cannot be used to make other and materially different products such as one that contains fillers, dyes, and/or cross-linking agents and the Examiner has not presented any evidence to support his/her position. The Group I and II inventions are not species because there is no generic claim and an article is not a polymer composition or visa versa. In addition, the same groups of claims were claimed in U.S. Patent No. 6,191,196 and no restriction requirement was issued. The inventions of Group I, II, and III are related and could all be searched in one search. Further, the inventions of Group I and II are classified in the same class and subclass and could all be searched in one search. Therefore, it is respectfully submitted that the restriction requirement is improper and should be withdrawn.

Applicants affirm the provisional election to prosecute the invention of Group I, claims 1 through 13 and 41, drawn to the invention of a polymer composition.

Claims 1 through 8 and 10 through 13 were rejected under 35 U.S.C. § 102(g) as being anticipated by Willet et al (U.S. Patent No. 6,191,196). Claims 1 through 8 and 10 through 13 were rejected under 35 U.S.C. § 102(g) as being directed to the same invention as that of

claims 1 through 7 and 9 through 13 of commonly assigned U.S. Patent No. 6,191,196.

Applicants respectfully traverse both rejections.

35 U.S.C. § 102 provides a person shall be entitled to a patent unless-

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Based on the above law, there is not an interference under section 135 or section 291 and therefore 35 U.S.C. § 102(g)(1) does not apply. As to 35 U.S.C. § 102(g)(2), the invention of the present application was not made in this country by another inventor who had not abandoned, suppressed, or concealed it. The present application is a Continuation-In-Part (CIP) of the '196 patent and was filed on March 28, 2000 and named inventors Willett, Doane, and Garlotta. The '196 patent issued on February 20, 2001 and named inventors Willett and Doane. For the record, the assignees of the present application are also the assignees of U.S. Patent No. 6,191,196. For the record, the entity of U.S. Patent No. 6,191,196 is the prior inventor of any allegedly conflicting subject matter. As a result, 35 U. S.C. § 102(g) does not apply and the rejection is inappropriate. Therefore, it is respectfully submitted that claims 1 through 8 and 10 through 13 are allowable over the rejections under 35 U.S.C. § 102(g).

Claims 1 through 8 and 10 through 13 were rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 through 7 and 9 through 13 of prior U.S. Patent No. 6,191,196 B1. Applicants respectfully traverse this rejection.

The test for the same invention is whether the claims being compared could be literally infringed by each other. The court noted that “[a] good test, and probably the only objective test, for ‘same invention,’ is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention.” In re Vogel, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A.).

Claim 1 has been amended to delete the phrase “hydroxy-functional polymer” and to add the phrase “adipic polyester. Based on this amendment and In re Vogel, claims 1 through 8 and 10 through 13 could literally infringe claims 1 through 7 and 9 through 13 of the ‘196 patent because adipic polyester is a hydroxy-functional polymer, but claims 1 through 7 and 9 through 13 of the ‘196 could not literally infringe claims 1 through 8 and 10 through 13 of the present application because a hydroxy-functional polymer is not an adipic polyester. Therefore, it is respectfully submitted that claims 1 through 8 and 10 through 13 are allowable over the rejection under 35 U.S.C. § 101.

Claims 1 through 8 and 10 through 13 were rejected under 35 U.S.C. § 102(e) as being anticipated by Willett et al. ‘196. Applicants respectfully traverse this rejection.

U.S. Patent No. 6,191,196 to Willett et al. discloses biodegradable polymer compositions, methods for making same and articles therefrom. The present application is a Continuation-In-Part (CIP) of the ‘196 patent and was filed on March 28, 2000 and named inventors Willett, Doane, and Garlotta. The ‘196 patent issued on February 20, 2001 and named inventors Willett and Doane.

Willet et al. '196 is not prior art to the claimed invention of claims 1 through 8 and 10 through 13. Specifically, the present application and the Willett et al. '196 patent share one or more persons as joint inventors and the present application and the application which matured into the Willett et al. '196 patent grew from the same original application. The present application claims and is entitled to the effective filing date of the common parent application, which is April 12, 1999 under 35 U.S.C. § 120. Further, the claimed invention of claims 1 through 8 and 10 through 13 is not by "another" for purposes of Section 102(e) even if there is overlap between the two inventive entities. As a result, the Willet et al. '196 patent cannot be 102(e) prior art to claims 1 through 8 and 10 through 13 of the present application. Therefore, it is respectfully submitted that claims 1 through 8 and 10 through 13 are allowable over the rejection under 35 U.S.C. § 102(e).

Claims 1 through 3, 9, and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Willet et al. (U.S. Patent No. 5,852,078). Applicants respectfully traverse this rejection.

U.S. Patent No. 5,852,078 to Willet et al. discloses biodegradable polyester compositions with natural polymers and articles therefrom. Compositions include a hydroxy-functional polyester and a natural polymer. Willett et al. does not disclose a third component being a thermoplastic polyester.

In contradistinction, claim 1, as amended, clarifies the invention claimed as a polymer composition including a first component being an adipic polyester, a second component being a natural polymer, and a third component being a thermoplastic polyester. The first component, second component and third component are combined to form the polymer composition.

A rejection grounded on anticipation under 35 U.S.C. § 102 is proper only where the subject matter claimed is identically disclosed or described in a reference. In other words, anticipation requires the presence of a single prior art reference which discloses each and every element of the claimed invention arranged as in the claim. In re Arkley, 455 F.2d 586, 172 U.S.P.Q. 524 (C.C.P.A. 1972); Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983); Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481 (Fed. Cir. 1984).

Willet et al. '078 does not disclose or anticipate the claimed invention of claims 1 through 8 and 10 through 13. Willet et al. '078 merely discloses biodegradable polyester compositions with natural polymers and articles therefrom, which compositions include a hydroxy-functional polyester and a natural polymer. Willet et al. '078 lacks a third component being a thermoplastic polyester. In Willet et al. '078, there is only a first component being a hydroxy-functional polymer and a second component being a natural polymer. Willet et al. '078 fails to disclose the combination of a polymer composition including a first component being an adipic polyester, a second component being a natural polymer, and a third component being a thermoplastic polyester, wherein the first component, second component and third component are combined to form the polymer composition as claimed by Applicants. Therefore, it is respectfully submitted that claim 1 and the claims dependent therefrom are allowable over the rejection under 35 U.S.C. § 102(b).

Claims 1 through 3 and 9 through 11 were rejected under 35 U.S.C. § 103 as being unpatentable over Willet et al. '078. Applicants respectfully traverse this rejection.

The United States Court of Appeals for the Federal Circuit (CAFC) has stated in determining the propriety of a rejection under 35 U.S.C. § 103, it is well settled that the obviousness of an invention cannot be established by combining the teachings of the prior art

absent some teaching, suggestion or incentive supporting the combination. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). The law followed by our court of review and the Board of Patent Appeals and Interferences is that “[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” In re Rinehart, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976). See also In re Lalu, 747 F.2d 703, 705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984) (“In determining whether a case of prima facie obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification.”)

Willet et al. ‘078 does not teach or suggest the claimed invention of claim 1. Specifically, Willet et al. ‘078 merely discloses biodegradable polyester compositions with natural polymers and articles therefrom, which compositions include a hydroxy-functional polyester and a natural polymer. Willet et al. ‘078 lacks a third component being a thermoplastic polyester. In Willet et al. ‘078, there is only a first component being a hydroxy-functional polymer and a second component being a natural polymer. Contrary to the Examiner’s position, the polyester of Willet et al. ‘078 is a hydroxy-functional polymer and cannot cover a thermoplastic polyester, which is not a hydroxy-functional polymer. Willet et al. ‘078, if modifiable, fails to teach or suggest the combination of a polymer composition including a first component being an adipic polyester, a second component being a natural polymer, and a third component being a thermoplastic polyester, wherein the first component, second component and third component are combined to form the polymer composition as claimed by Applicants. The


claimed invention is novel and unobvious because the polymer compositions contain starch and a hydroxy-functional polymer such as poly(hydroxy ester ether)(PHEE) and a thermoplastic polyester such as poly(lactic acid)(PLA). Therefore, it is respectfully submitted that claim 1 and the claims dependent therefrom are allowable over the rejection under 35 U.S.C. § 103.

Claims 4 through 8, 12, and 13 were rejected under 35 U.S.C. § 103 as being unpatentable over Willet et al. '078 and further in view of Mang et al. '225. Applicants respectfully traverse this rejection for the same reasons given above to claim 1.

Obviousness under § 103 is a legal conclusion based on factual evidence (In re Fine, 837 F.2d 1071, 1073, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988), and the subjective opinion of the Examiner as to what is or is not obvious, without evidence in support thereof, does not suffice. Since the Examiner has not provided a sufficient factual basis, which is supportive of his/her position (see In re Warner, 379 F.2d 1011, 1017, 154 U.S.P.Q. 173, 178 (C.C.P.A. 1967), cert. denied, 389 U.S. 1057 (1968)), the rejections of claims 1 through 13 are improper. Therefore, it is respectfully submitted that claims 1 through 13 are allowable over the rejections under 35 U.S.C. § 103.

Based on the above, it is respectfully submitted that the claims are in a condition for allowance, which allowance is solicited.

Respectfully submitted,

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